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10/577,082

04/02/2007

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05/04/2009

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EXAMINER

PATEL, KIRAN B

ART UNIT

PAPER NUMBER

3612

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/577,082 | Applicant(s) LIEDMEYER ET AL. | |
| | Examiner Kiran B. Patel | Art Unit 3612 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Final Rejection (5/4/09)

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The elected drawings must show every feature of the elected invention specified in the elected claims. Following are few examples (at least one bow (6, 7) is designed with has multiple parts and a middle section (9) that is connected permanently and immovably to lateral mounting fixtures (10), further comprising fastening means for connecting the middle section (9) to the mounting fixtures (10), wherein when the roof is closed, the fastening means extend parallel to the plane (17; 18) of the outer roof covering (4) in an area of each bow (6; 7).) of the underlined limitations which must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Above are just few examples and therefore, the Applicant is requested to go through the application and ensure that all claimed limitations are shown in the drawing in such a way as to convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. Applicant is requested to provide complete explanation for each replacement-drawing as to what was changed in which figure and why (include reference numbers).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recite "at least one bow (6, 7) is designed with has multiple parts and a middle section (9) that is connected permanently and immovably to lateral mounting fixtures (10), further comprising fastening means for connecting the middle section (9) to the mounting fixtures (10), wherein when the roof is closed, the fastening means extend parallel to the plane (17; 18) of the outer roof covering (4) in an area of each bow (6; 7)". Underlined limitations are not fully explained in the specification and/or not clearly shown in the figures to show that the Applicant had possession of the claimed invention.

Above are just few examples of the discrepancies and therefore the Applicant is requested to go through the application and ensure that the claimed matter has been described in the specification and shown in the drawing in such a way as to convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-10, as best understood, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 1, "at least one bow (6, 7) is designed with has multiple parts and a middle section (9) that is connected permanently and immovably to lateral mounting fixtures (10), further comprising fastening means for connecting the middle section (9) to the mounting fixtures (10), wherein when the roof is closed, the fastening means extend parallel to the plane (17; 18) of the outer roof covering (4) in an area of each bow (6; 7)" underlined limitations fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 8, "essentially elliptical" fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102(b)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 9, 10, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Shiromura (6,068,326).

Regarding Claims 1, 2, 9, 10, Shiromura (6,068,326) as best understood, discloses the invention as claimed to include a movable vehicle roof for a convertible vehicle which is at least partially covered with a flexible roof covering 5, which is supported from below by one or more bows 7 that extend transversely to the direction of vehicle travel, wherein at least one bow is designed with multiple parts and has a middle section that is connected to lateral mounting fixtures 9-10, wherein, to connect the middle section to the mounting fixtures, fastening means 12a are provided, which, when the roof is closed, are parallel to the plane of the outer roof covering in the area of each bow Fig 1-14; wherein the mounting fixtures engage positively with the middle section, and in that the fastening means pass through both parts Fig 1-14; wherein the mounting fixture has a flattened shape Fig 4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 4, 5, 8, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiromura (6,068,326) and further in view of Cowsert (5,829,820).

Regarding Claims 3, 4, 5, 8, Shiromura (6,068,326) discloses the invention as claimed.

However, Shiromura does not disclose (6,068,326) a retaining channel; a recessed insertion region; and elliptical bow.

Cowsert (5,829,820) discloses a retaining channel 18; a recessed insertion region Fig 4; and elliptical bow Fig 4.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention, as disclosed by Shiromura (6,068,326), to include a retaining channel; a recessed insertion region; and elliptical bow, as disclosed by Cowsert (5,829,820), to provide elliptical bow with a retaining channel.

As to claims 6-7, as best understood, given the device of Shiromura (6,068,326) in view of Cowsert (5,829,820), it would have been obvious to widen the insertion towards the center.

Applicant may seasonally challenge, for the official record in this application, this and any other statement of judicial notice in timely manner in response to this office action. Please specify the exact statement to be challenged. Applicant is reminded, with respect to the specific challenge put forth, of the duty of disclosure under Rule 56 to disclose material which is pertinent to patentability including claim rejections challenged by applicant.

Response to Arguments

1. Applicant's arguments filed 02/13/09 have been fully considered but they are not persuasive.

The language objected by the Examiner has not been removed from claim 8.

Review of the specification for this application clearly shows and for the record it should be made clear that (1) reference 12 is pivot portion and not pivoting bodies; (2) reference 12a is pivot shaft and not shaft like sleeves; (3) reference A is fulcrum and not axis; (4) reference B is an operation point and not an axis; (4) reference b is pivotally supporting portion and not axis; used in Applicant's argument.

In response to applicant's argument that the references fail to show, teach or suggest certain features of applicant's invention, it is noted that the features upon which applicant relies (As mentioned above, the claim now recites the connection between the middle portion and the lateral portions as being permanent and immovable in order to clearly distinguish the present invention over the prior art. The forth paragraph after the brief description of the drawing of the present application and, therefore, no new matter has been added.) are not recited in the original specification. Also, it is not found as argued - The forth paragraph after the brief description of the drawing of the present application and, therefore, no new matter has been added. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiran B. Patel whose telephone number is 571-

272-6665. The examiner can normally be reached on M-F 8:00 to 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 571-272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

4. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kiran B. Patel/

Kiran B. Patel P.E.
Primary Examiner
Art Unit 3612